

DATE

TO

SUBJECT

Supervisor, Art Unit

Certificate of Correction Request in Patent No.

3600

RUSH

5907617

A response to the following question(s) is requested with respect to the accompanying request for a certificate of correction.

- ☒ 1. Would the change(s) requested under 37 CFR 1.323 constitute new matter or require reexamination of the application?
- ☐ 2. Would the change(s) requested under 37 CFR 1.323 Materially affect the scope or meaning of the claims allowed by the examiner in the patent?
- ☐ 3. Applicant disagrees with change(s) initialed and dated by Examiner in lieu of an Examiner's Amendment. Should the change request be granted?
- ☒ 4. With respect to the change(s) requested, correcting ~~Office~~ errors, should the patent read as shown in the certificate of correction?
- ☐ 5. If the amendment filed _____ had been considered by the Examiner, would the amendment have been entered?

PLEASE RESPOND WITHIN 7 DAYS AND RETURN THE FILE TO
ROOM 918, PK III

Valerie Gable
Legal Instrument Examiner

TO: CERTIFICATE OF CORRECTION BRANCH

DATE: 10/25/00

The decision regarding the change(s) requested in the certificate of correction is shown below.

- | | | |
|--|--|---|
| <input type="checkbox"/> 1. YES | <input checked="" type="checkbox"/> NO | <input type="checkbox"/> Comments below |
| <input type="checkbox"/> 2. YES | <input type="checkbox"/> NO | <input type="checkbox"/> Comments below |
| <input type="checkbox"/> 3. YES | <input type="checkbox"/> NO | <input type="checkbox"/> Comments below |
| <input checked="" type="checkbox"/> 4. YES | <input type="checkbox"/> NO | <input type="checkbox"/> Comments below |
| <input type="checkbox"/> 5. YES | <input type="checkbox"/> NO | <input type="checkbox"/> Comments below |

☐ Comments _____

Thomas H. Jarczy
Supervisor

3662
Art Unit

PATENT COOPERATION TREATY

RECEIVED

From the INTERNATIONAL SEARCHING AUTHORITY

OCT 18 1996

To: STEVEN C. BRUESS
MERCHANT, GOULD, SMITH, EDELL, WELTER &
SCHMIDT
3100 NORWEST CENTER
90 SOUTH SEVENTH STREET
MINNEAPOLIS, MINNESOTA 55402

OCT 18 1996

PCT

MERCHANT & GOULD
MINNEAPOLIS, MN 55402NOTIFICATION OF TRANSMITTAL OF
THE INTERNATIONAL SEARCH REPORT
OR THE DECLARATION

Aly. Resp.

(PCT Rule 44.1)

Aly. 125 in US

15 Dec 96

15 Jan 97

Date of Mailing
(day/month/year)

15 OCT 1996

Applicant's or agent's file reference
10678.1W001

FOR FURTHER ACTION See paragraphs 1 and 4 below

International application No.
PCT/US96/09916International filing date
(day/month/year)
07 JUNE 1996Applicant
DIGITAL RIVER, INC.

- 1.
- ☒
- The applicant is hereby notified that the international search report has been established and is transmitted herewith.

Filing of amendments and statement under Article 19:

The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46):

When? The time limit for filing such amendments is normally 2 months from the date of transmittal of the international search report; however, for more details, see the notes on the accompanying sheet.

Where? Directly to the International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland
Facsimile No.: (41-22) 740.14.35

For more detailed instructions, see the notes on the accompanying sheet.

- 2.
- ☐
- The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect is transmitted herewith.

- 3.
- ☐
- With regard to the protest against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:

☐ the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.☐ no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. Further action(s): The applicant is reminded of the following:

Shortly after 18 months from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in rules 90 bis 1 and 90 bis 3, respectively, before the completion of the technical preparations for international publication.

Within 19 months from the priority date, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until 30 months from the priority date (in some Offices even later).

Within 20 months from the priority date, the applicant must perform the prescribed acts for entry into the national phase before all designated Offices which have not been elected in the demand or in a later election within 19 months from the priority date or could not be elected because they are not bound by Chapter II.

Name and mailing address of the ISA/US
Commissioner of Patents and Trademarks
Box PCT
Washington, D.C. 20231

Facsimile No. (703) 305-3230

Authorized officer

PINCHUS M. LAUFER

Telephone No. (703) 306-4177

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference 10678.1W001	FOR FURTHER ACTION see Notification of Transmittal of International Search Report (Form PCT/ISA/Z20) as well as, where applicable, item 5 below.	
International application No. PCT/US96/09916	International filing date (day/month/year) 07 JUNE 1996	(Earliest) Priority Date (day/month/year) 07 JUNE 1995
Applicant DIGITAL RIVER, INC.		

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 1 sheets.

☒ It is also accompanied by a copy of each prior art document cited in this report.

1. ☐ Certain claims were found unsearchable (See Box I).
2. ☒ Unity of invention is lacking (See Box II).
3. ☐ The international application contains disclosure of a nucleotide and/or amino acid sequence listing and the international search was carried out on the basis of the sequence listing
 - ☐ filed with the international application.
 - ☐ furnished by the applicant separately from the international application,
 - ☐ but not accompanied by a statement to the effect that it did not include matter going beyond the disclosure in the international application as filed.
 - ☐ transcribed by this Authority.
4. With regard to the title, ☒ the text is approved as submitted by the applicant.
 - ☐ the text has been established by this Authority to read as follows:
5. With regard to the abstract,
 - ☒ the text is approved as submitted by the applicant.
 - ☐ the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box III. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.
6. The figure of the drawings to be published with the abstract is:

Figure No. _____

 - ☐ as suggested by the applicant.
 - ☐ because the applicant failed to suggest a figure.
 - ☐ because this figure better characterizes the invention.

☒ None of the figures.

Box I Observations where certain claims were found unsearchable (Continuation of item 1 of first sheet)

This international report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:

1. ☐ Claims Nos.:
because they relate to subject matter not required to be searched by this Authority, namely:

2. ☐ Claims Nos.:
because they relate to parts of the international application that do not comply with the prescribed requirements to such an extent that no meaningful international search can be carried out, specifically:

3. ☐ Claims Nos.:
because they are dependent claims and are not drafted in accordance with the second and third sentences of Rule 6.4(a).

Box II Observations where unity of invention is lacking (Continuation of item 2 of first sheet)

This International Searching Authority found multiple inventions in this international application, as follows:

Please See Extra Sheet.

1. ☒ As all required additional search fees were timely paid by the applicant, this international search report covers all searchable claims.
2. ☐ As all searchable claims could be searched without effort justifying an additional fee, this Authority did not invite payment of any additional fee.
3. ☐ As only some of the required additional search fees were timely paid by the applicant, this international search report covers only those claims for which fees were paid, specifically claims Nos.:

4. ☐ No required additional search fees were timely paid by the applicant. Consequently, this international search report is restricted to the invention first mentioned in the claims; it is covered by claims Nos.:

Remark on Protest

☐

The additional search fees were accompanied by the applicant's protest.

☒

No protest accompanied the payment of additional search fees.

A. CLASSIFICATION OF SUBJECT MATTER

IPC(6) : H04L 9/00; H04K 1/00; G06F 9/00, 15/00

US CL : 380/4, 25; 395/186, 218, 226, 227, 700; 364/400; 340/825.31

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

U.S. : Please See Extra Sheet.

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)

APS

Search terms: SELF, LAUNCH, PROGRAM, SOFTWARE, KIOSK, VENDING

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
	Please See Continuation of Second Sheet.	

☒ Further documents are listed in the continuation of Box C. ☐ See patent family annex.

* Special categories of cited documents:	*T	later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
A document defining the general state of the art which is not considered to be of particular relevance	*X*	document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
E earlier document published on or after the international filing date	*Y*	document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
L document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)	*G*	document member of the same patent family
O document referring to an oral disclosure, use, exhibition or other means		
P document published prior to the international filing date but later than the priority date claimed		

Date of the actual completion of the international search

20 SEPTEMBER 1996

Date of mailing of the international search report

15 OCT 1996

Name and mailing address of the ISA/US
Commissioner of Patents and Trademarks
Box PCT
Washington, D.C. 20231

Facsimile No. (703) 305-3230

Authorized officer

PINCHUS M. LAUFER

Telephone No. (703) 306-4177

INTERNATIONAL SEARCH REPORT

International application No.

PCT/US96/09916

C (Continuation). DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X --- Y	US, A, 5,341,429 (STRINGER ET AL.) 23 August 1994, see entire document.	1-3, 5, 7-12, 14-16, 18, 20-25, 27, 28, 30-36, 38-42, 44-45, 47-50, 52-53, 55-58, 60, 61-67, 69, 70-76, 78, 79, 81-83, 85, 87-89, 91, 101-103, 105-107, 109-115, 117-119, and 121-125 ----- 6, 19, 29, 37, 46-47, 51, 54-55, 59, 69, 77, 101-103, 105-108, 110-115, 117-120, 122-125
X --- Y	US, A, 4,658,093 (HELLMAN) 14 April 1987, see entire document.	1, 5, 7, 11-14, 18, 20, 24-28, 30, 35, 36, 38, 43 79, 81-83, 85, 87-89, 91 ----- 6, 19, 29, 37
X --- Y	US, A, 4,446,519 (THOMAS) 01 May 1984, see entire document.	1, 2, 11, 14, 15, 24, 27, 33, 39, 41 ----- 6, 19, 29, 37
X	US, A, 4,465,901 (BEST) 14 August 1984, see entire document.	1, 2, 5, 7-9, 14, 15, 18, 20-22, 27, 28, 30-33, 35, 36, 38-41

C (Continuation). DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X --- Y	US, A, 4,654,799 (OGAKI ET AL) 31 March 1987, see entire document.	1, 2, 4, 10-12, 14, 15, 17, 23- 25, 27, 33-35, 40-41, 44, 49-50, 52, 57-58, 61-67, 70-76, 101-106, 112- 118, and 124 ----- 4, 6, 17, 19, 29, 37, 46, 47, 51, 54, 55, 59, 68, 77, 101-103, 105-108, 110- 115, 117-120, 122-125
X --- Y	US, A, 5,327,563 (SINGH) 05 July 1994, see entire document.	1-3, 5, 9, 12, 14- 16, 18, 22, 25, 27, 28, 32, 33, 35, 36, 40, 41 ----- 6, 19, 29, 37
X --- Y	US, A, 5,109,413 (COMERFORD ET AL.) 28 April 1992, see entire document.	1-3, 5, 8-9, 11, 14-16, 18, 21-22, 24, 27-28, 31-33, 35-36, 39-41 ----- 6, 19, 29, 37
X	US, A, 5,388,211 (HORNBUCKLE) 07 February 1995, see entire document.	1-3, 5, 9, 11-12, 14-16, 18, 22, 24-25, 27-28, 32- 33, 35-36, 40-41
Y, E	US, A, 5,530,865 (OWENS ET AL.) 25 June 1996, see entire document.	92-100
Y, P	US, A, 5,495,411 (ANANDA) 27 February 1996, see entire document.	92-100
Y	US, A, 4,787,050 (SUZUKI) 22 November 1988, see entire document.	4, 17

INTERNATIONAL SEARCH REPORT

International application No.

PCT/US96/09916

C (Continuation). DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X --- Y	US, A, 4,740,890 (WILLIAM) 26 April 1988, see entire document.	61-62, 64-66, 68-71, 73-75, 77-78 ----- 6, 19, 29, 37, 46, 54, 108, 120
X --- Y	US, A, 4,796,220 (WOLFE) 03 January 1989, see entire document.	79, 81-83, 85, 87-89, ----- 102, 114
X	US, A, 3,990,710 (HUGHES) 09 November 1976, see entire document.	61-63, 65-67, 70-72, 74-76
X --- Y	US, A, 5,355,302 (MARTIN ET AL) 11 October 1994, see entire document.	61-78 79, 81-83, 85, 87-89, 91 ----- 51, 59 68, 77
X	US, A, 5,166,886 (MOLNAR ET AL) 24 November 1992, see entire document.	44-60, 61-78
X --- Y	US, A, 4,827,508 (SHEAR) 02 May 1989, see entire document.	79, 81-83, 85, 87-89 ----- 47, 55
X	US, A, 5,014,234 (EDWARDS JR.) 07 May 1991, see entire document.	79, 81-83, 85, 87-89, 91
A	US, A, 5,010,571 (KATZNELSON) 23 April 1991.	
A	US, A, 4,490,810 (HON) 25 December 1984	
A, P	US, A, 5,509,070 (SCHULL) 16 April 1996	
A	US, A, 5,237,157 (KAPLAN) 17 August 1993	

B. FIELDS SEARCHED

Minimum documentation searched
Classification System: U.S.

380/4, 25

364/949.81, 969, 969.4, 286.6, 400, 401R, 726, 856

395/186, 187.01, 188.01, 490, 491, 650, 700

340/825.31, 825.34

BOX II. OBSERVATIONS WHERE UNITY OF INVENTION WAS LACKING

This ISA found multiple inventions as follows:

Group I. Claims 1-43: Systems and Methods for demonstrating software and obtaining marketing information.

Group II. Claims 44-60: Self launching system and method for demonstrating software.

Group III. Claims 61-78: Self launching systems and methods for distributing software and digital information.

Group IV. Claims 79-91: System and method for storing a code within an operating system .

Group V. Claims 92-100: System and method for preventing unauthorized duplication of an executing software program.

Group VI. Claims 101-126: Computer based system and method for automatic sales of software.

There is no common special technical feature relating the groups.

Groups 1, 2, 3, 4, and 6 are related as subcombinations usable together.

Group 5 is related to groups 1, 2, and 6 as a subcombination not essential to the combination. Groups 5, 3, and 4 are related to each other as subcombinations usable together.

CHAPTER I
PCT TELEPHONE MEMORANDUM
FOR
LACK OF UNITY OF INVENTION



PCT No.: PCT/US96/09916

Examiner: Pinchus M. Laufer

Attorney spoken to: Steven C. Breuss for John P. Sumner

Date of call: 12 SEPTEMBER 1996

- ☒ Amount of payment approved: \$ 950.00
- ☒ Deposit account number to be charged: 13-2725
- ☒ Attorney elected to pay for ALL additional inventions
- ☐ Attorney elected to pay only for the additional inventions covered by
 - ☐ Group(s):
 - encompassing --
 - ☐ Claim(s):
- ☐ Attorney elected **NOT** to pay for any additional inventions, therefore, only the first claimed invention (Group I) covered by Claim(s) _ has been searched.
- ☒ Attorney was orally advised that there is no right to protest for any group not paid for.
- ☒ Attorney was orally advised that any protest must be filed no later than 15 days from the mailing of the Search Report (PCT/ISA/210).

Time Limit For Filing A Protest

Applicant is hereby given 15 days from the mailing date of this Search Report in which to file a protest of the holding of lack of unity of invention. In accordance with PCT Rule 40.2, applicant may protest the holding of lack of unity only with respect to the group(s) paid for.

Detailed Reasons For Holding Lack of Unity If Invention:
(Continued on a separate sheet)

Note: A copy of this form must be attached to the Search Report.

**ATTACHMENT TO CHAPTER I PCT TELEPHONE MEMORANDUM
FOR
LACK OF UNITY OF INVENTION**

Detailed Reasons For Holding Lack Of Unity Of Invention:

Group I. Claims 1-43: Systems and Methods for demonstrating software and obtaining marketing information.

Group II. Claims 44-60: Self launching system and method for demonstrating software.

Group III. Claims 61-78: Self launching systems and methods for distributing software and digital information.

Group IV. Claims 79-91: System and method for storing a code within an operating system.

Group V. Claims 92-100: System and method for preventing unauthorized duplication of an executing software program.

Group VI. Claims 101-126: Computer based system and method for automatic sales of software.

There is no common special technical feature relating the groups.

Groups 1, 2, 3, 4, and 6 are related as subcombinations usable together.

Group 5 is related to groups 1, 2, and 6 as a subcombination not essential to the combination.

Groups 5, 3, and 4 are related to each other as subcombinations usable together.

NOTES TO FORM PCT/ISA/220 (continued)

The letter must indicate the differences between the claims as filed and the claims as amended. It must, in particular, indicate, in connection with each claim appearing in the international application (it being understood that identical indications concerning several claims may be grouped), whether

- (i) the claim is unchanged;
- (ii) the claim is cancelled;
- (iii) the claim is new;
- (iv) the claim replaces one or more claims as filed;
- (v) the claim is the result of the division of a claim as filed.

The following examples illustrate the manner in which amendments must be explained in the accompanying letter:

1. [Where originally there were 48 claims and after amendment of some claims there are 51]:
"Claims 1 to 29, 31, 32, 34, 35, 37 to 48 replaced by amended claims bearing the same numbers; claims 30, 33 and 36 unchanged; new claims 49 to 51 added."
2. [Where originally there were 15 claims and after amendment of all claims there are 11]:
"Claims 1 to 15 replaced by amended claims 1 to 11."
3. [Where originally there were 14 claims and the amendments consist in cancelling some claims and in adding new claims]:
"Claims 1 to 6 and 14 unchanged; claims 7 to 13 cancelled; new claims 15, 16 and 17 added." or
"Claims 7 to 13 cancelled; new claims 15, 16 and 17 added; all other claims unchanged."
4. [Where various kinds of amendments are made]:
"Claims 1-10 unchanged; claims 11 to 13, 18 and 19 cancelled; claims 14, 15 and 16 replaced by amended claim 14; claim 17 subdivided into amended claims 15, 16 and 17; new claims 20 and 21 added."

"Statement under Article 19(1)" (Rule 46.4)

The amendments may be accompanied by a statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings (which cannot be amended under Article 19(1)).

The statement will be published with the international application and the amended claims.

It must be in the language in which the international application is to be published.

It must be brief, not exceeding 500 words in English or if translated into English.

It should not be confused with and does not replace the letter indicating the differences between the claims as filed and as amended. It must be filed on a separate sheet and must be identified as such by a heading, preferably by using the words "Statement under Article 19(1)."

It may not contain any disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

Consequence if a demand for international preliminary examination has already been filed

If, at the time of filing any amendments under Article 19, a demand for international preliminary examination has already been submitted, the applicant must preferably, at the same time of filing the amendments with the International Bureau, also file a copy of such amendments with the International Preliminary Examining Authority (see Rule 62.2(a), first sentence).

Consequence with regard to translation of the international application for entry into the national phase

The applicant's attention is drawn to the fact that, upon entry into the national phase, a translation of the claims as amended under Article 19 may have to be furnished to the designated/elected Offices, instead of, or in addition to, the translation of the claims as filed.

For further details on the requirements of each designated/elected Office, see Volume II of the PCT Applicant's Guide.

NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under Article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the PCT Applicant's Guide, a publication of WIPO.

In these Notes, "Article", "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions, respectively.

INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only.

What parts of the international application may be amended?

Under Article 19, only the claims may be amended.

During the international phase, the claims may also be amended (or further amended) under Article 34 before the International Preliminary Examining Authority. The description and drawings may only be amended under Article 34 before the International Preliminary Examining Authority.

Upon entry into the national phase, all parts of the international application may be amended under Article 28 or, where Applicable, Article 41.

When ? Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

Where not to file the amendments ?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

How ? Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Administrative Instructions, Section 205(b)).

The amendments must be made in the language in which the international application is to be published.

What documents must/may accompany the amendments ?

Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.

NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under Article 19. The Notes are based on the requirements of the Patent Cooperation Treaty and of the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the PCT Applicant's Guide, a publication of WIPO.

In these Notes, "Article", "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions, respectively.

INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only.

What parts of the international application may be amended ?

The claims only.

The description and the drawings may only be amended during international preliminary examination under Chapter II.

When ? Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

Where not to file the amendments ?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

How ? Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Administrative Instructions, Section 205(b)).

What documents must/may accompany the amendments ?

Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confounded with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

The letter must indicate the differences between the claims as filed and the claims as amended. It must, in particular, indicate, in connection with each claim appearing in the international application (it being understood that identical indications concerning several claims may be grouped), whether

- (i) the claim is unchanged;
- (ii) the claim is cancelled;
- (iii) the claim is new;
- (iv) the claim replaces one or more claims as filed;
- (v) the claim is the result of the division of a claim as filed.

NOTES TO FORM PCT/ISA/220 (continued)

The following examples illustrate the manner in which amendments must be explained in the accompanying letter:

1. [Where originally there were 48 claims and after amendment of some claims there are 51]:
"Claims 1 to 29, 31, 32, 34, 35, 37 to 48 replaced by amended claims bearing the same numbers; claims 30, 33 and 36 unchanged; new claims 49 to 51 added."
2. [Where originally there were 15 claims and after amendment of all claims there are 11]:
"Claims 1 to 15 replaced by amended claims 1 to 11."
3. [Where originally there were 14 claims and the amendments consist in cancelling some claims and in adding new claims]:
"Claims 1 to 6 and 14 unchanged; claims 7 to 13 cancelled; new claims 15, 16 and 17 added." or
"Claims 7 to 13 cancelled; new claims 15, 16 and 17 added; all other claims unchanged."
4. [Where various kinds of amendments are made]:
"Claims 1-10 unchanged; claims 11 to 13, 18 and 19 cancelled; claims 14, 15 and 16 replaced by amended claim 14; claim 17 subdivided into amended claims 15, 16 and 17; new claims 20 and 21 added."

"Statement under Article 19(1)" (Rule 46.4)

The amendments may be accompanied by a statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings (which cannot be amended under Article 19(1)).

The statement will be published with the international application and the amended claims.

The statement should be brief, it should not exceed 500 words if in English or if translated into English.

It should not be confounded with and does not replace the letter indicating the differences between the claims as filed and as amended. It must be filed on a separate sheet and must be identified as such by a heading, preferably by using the words "Statement under Article 19(1)."

It should not contain any disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

In what language ?

The amendments must be made in the language in which the international application is published. The letter and any statement accompanying the amendments must be in the same language as the international application if that language is English or French; otherwise, it must be in English or French, at the choice of the applicant.

Consequence if a demand for international preliminary examination has already been filed ?

If, at the time of filing any amendments under Article 19, a demand for international preliminary examination has already been submitted, the applicant must preferably, at the same time of filing the amendments with the International Bureau, also file a copy of such amendments with the International Preliminary Examining Authority (see Rule 62.2(a), first sentence).

Consequence with regard to translation of the international application for entry into the national phase ?

The applicant's attention is drawn to the fact that, where upon entry into the national phase, a translation of the claims as amended under Article 19 may have to be furnished to the designated/elected Offices, instead of, or in addition to, the translation of the claims as filed.

For further details on the requirements of each designated/elected Office, see Volume II of the PCT Applicant's Guide.